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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/574,987 05/12/00 BECKER

C 82408

EXAMINER
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IM22/0508

COMMANDING OFFICE  
OFFICE OF PATENT COUNSEL CODE D0012  
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TRAN. T	PAPER NUMBER
ART UNIT	

1741  
DATE MAILED:

05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/574,987**

Applicant(s)  
**Becker, Carol**

Examiner  
**Thao Tran**

Art Unit  
**1741**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 26, 2001
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-14 and 27-33 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. This is in response to the Reply received on April 26, 2001.
2. Claims 7-14 and 27-33 are currently pending in this application.
3. Claims 4-6 and 23-24 have been canceled; therefore, Applicant's arguments with respect to the Restriction Requirement are moot.

### ***Claim Objections***

4. Applicant is advised that should claim 14 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 7-14 and 27-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Zirino (US Pat. 5,334,629).

Zirino teaches an apparatus, comprising: a source of visible light for irradiating a solution with a wavelength and intensity to establish pH change in the solution and to cause a polymer in the solution undergo a change in volume when the solution is irradiated with the light (see Fig. 2; abstract; claim 1).

Moreover, in regards to claim 7, applicant is reminded that the solution and the polymer disposed in the solution are limitations on the material to be worked upon by the apparatus, and the manner by which an apparatus is operated is a process limitation. Both the material to be worked upon and the functional limitations have been held insufficient to patentably distinct over prior art when an apparatus claim is being considered for its patentability. See *In re Young*, 25 USPQ 69 (CCPA 1935); *In re Venner*, 120 USPQ 193, 194 (CCPA 1958).

In regards to claims 8-14 and 27-33, it has been known that the material to be worked upon by the apparatus has been held to have little patentable weight when an apparatus claim is being considered for its patentability. See *In re Young*, 25 USPQ 69 (CCPA 1935).

In regards to claims 8-9 and 28-29, Zirino teaches the polymer being a polyelectrolyte fiber and the polyelectrolyte fiber being PAA-PVA (see claims 1 and 4).

In regards to claims 10 and 30, Zirino teaches the pH change in the solution being within plus or minus 1 pH value of a null point pH value of the polyelectrolyte fiber (see claim 2).

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In regards to claims 11-12 and 31-32, Zirino teaches the polymer being a polymer gel and the polymer gel being an acrylamide gel (see col. 7, clines 7-8; claims 35-36, 38, 40).

In regards to claims 13 and 33, Zirino teaches the pH change in the solution being within plus or minus 1 pH value of a null point pH value of the polymer gel (see claim 36).

#### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ron et al. (US Pat. 5,935,593).

#### ***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao Tran whose telephone number is (703) 306-5698. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos, can be reached on (703) 308-3328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

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T.T.

May 7, 2001

  
Kathryn Goss  
Supervisory Patent Examiner  
Technology Center 1700